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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In the Application of: |) | Examiner: TBA |
| |) | |
| Ledbetter et al. |) | Group Art Unit: 1645 |
| |) | |
| Serial Nos.: 10/627,556 |) | Confirmation No.: 3297 |
| : PCT/US02/24918 |) | |
| Filed: July 26, 2003 |) | |
| |) | |
| For: BINDING CONSTRUCTS AND |) | |
| METHODS OF USE THEREOF |) | |
| |) | |

RENEWED PETITION FOR SUSPENSION OF RULES UNDER 37 C.F.R. § 1.183

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This request for reconsideration is responsive to the decision on petition mailed August 3, 2004, which is filed together with a five-month Request for Extension of Time that allows for timely filing of this submission up to and including March 3, 2005. Applicants request reconsideration and the suspension of 37 C.F.R. § 1.10 to correct the filing date for the reasons set forth in the Petition and Declarations filed June 28, 2004 and in this renewed Petition to correct an injustice that will result if the filing date is not corrected.

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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this communication is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Dated: March 3, 2005

By:


Gregory P. Austin

Petitioners Response to Dismissal of Petition

The decision on petition dated August 03, 2004 has dismissed Applicants' petition to correct the filing date of Application No. 10/627,556. The decision states in part:

petitioner is actually requesting waiver of a statutory requirement, not simply the requirements of a rule, insofar as petitioner is request a date other than the date the application was actually deposited with the United States Postal Service.In order to accord the subject application a filing date of July 25, 2003, the Commissioner would have to suspend the requirement implicit in 35 U.S.C. 21(a) that the filing date accorded in an application be the date the application was actually deposited with the United States Postal Service in favor of the date the application was intended to be deposited. (last paragraph first page, continuing to page 2).

Applicants respectfully disagree, and request that the decision on petition dated August 03, 2004 be reconsidered and withdrawn.

The facts presented by petitioner show that Ms. Kielt presented the same patent applications twice to employees at the United States Postal Service. First, Ms. Kielt presented the patent applications to a United States Postal Service employee for deposit at approximately 11:40 PM on the night of July 25, 2003. The Post Office employee was on duty and spoke with Ms. Kielt. However, he refused to accept the packages containing the patent applications. As a result of this refusal and at the instruction of the Post Office, Ms. Kielt was required to deposit the same packages again the next day.

The decision on petition takes the position that there is an implicit requirement in 35 U.S.C. 21(a) that the patent applications were actually deposited with the United States Postal Service. However, the decision on petition fails to provide an explanation or support for this alleged implicit requirement. Further, such an interpretation is inconsistent with the fact that the language of 35 U.S.C. 21(a) is permissive. 35 U.S.C. 21(a) provides "The Director may by rule

prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director." (emphasis added). The use of the term "may" is discretionary in characterizing the authorization granted to the Commissioner with respect to determining and designating what would have been deposited with the United States Postal Service but for postal service interruptions or emergencies.

The statute fails to explicitly make any requirement regarding an actual deposit, and the decision on petition does not support the allegation that there is an "implicit" requirement. Applicant also respectfully points out that i) there is no statutory requirement that promulgates the hours of operation for Express Mail at the United States Post Office; and ii) there is no statutory requirement that supports the Post Office employee's decision to not accept the packages.

The actions of Ms. Kielt on the night of July 25, 2003 constitute more than a mere intent to deposit the applications. Here, the Post Office employee, with knowledge that other United States Post Office's are open until 12:00 midnight for the acceptance of Express Mail, in effect exercised discretion in refusing to accept the packages. Ms. Kielt was not permitted to deposit the packages within the locked section of the United States Post Office. Applicants' position is that the action taken by the Post Office in refusing to accept the patent application was not mandated or necessary, and it is certainly not a course of action mandated by a implicit requirement of 35 U.S.C. 21.

Further, 35 U.S.C. 21 states that it is entirely within the discretion of the Director to determine and designate what circumstances constitute a postal service interruption. Accordingly, it is within the commissioners discretion to make the determination that the United States Post Office employee's refusal to accept the Express Mail packages presented well before midnight on July 25, 2003 constitutes such an interruption in postal service as explicitly provided by 35 U.S.C. 21. Petitioner respectfully submits that, if required, such a determination is warranted and required to remedy the actions taken by the United States Post Office in refusing to accept PTO packages presented for filing before the time for filing them expired.

The August 4, 2004 decision on petition further states, in part:

It is also noted that petitioner makes an effort to explain that extraordinary care and diligence were exercised in the preparation of the patent application such that justice would require suspension of the requirements under 37 C.F.R. 1.10. Petitioner's efforts are noted, however, petitioner failed to mention that petitioner waited until nearly midnight on the last day the application could be deposited with the USPS to satisfy petitioner's requirements relative to the PCT application.it may be argued that petitioners' unawareness of the new post office hours, and consequential failure to deposit the application with the USPS before the last scheduled pick-up, while unfortunate, is not an extraordinary situation that would warrant waiver of the requirements of 37 C.F.R. 1.10. (second paragraph, page 2)

Applicants respectfully disagrees with this characterization. These assertions fail to take into consideration all of the facts. This decision fails to give any consideration to the fact there was a critical delay resulting from the unexpected shut down of the server that supports all of the computers and printers in the San Diego office of Buchanan Ingersoll LLP at approximately 10:00 p.m. (Collett Decl. ¶ 8; Hon Decl. ¶ 3; Kielt Decl. ¶ 8). Further, the IP group at Buchanan Ingersoll LLP was not only new to the firm on July 25, 2003, it was small. The entire IP group in San Diego that night consisted of one attorney, one law

clerk, and one intellectual property administrative assistant. As mentioned in the petition dated June 28, 2004, Applicants' attorneys were working diligently on the finalization of the patent applications, there was no staff in place to allow the duplication of time and efforts that would have been required to repeat the task of delivering and depositing two separate patent applications to the United States Post Office on the same day when the task could be completed as one single event. This cannot, in any event, work to Applicants' detriment when both applications were presented to the United States Post Office, the sole agent of the Patent and Trademark Office for such matters, for filing on the due date.

But for the unexpected computer shut down, there was every reasonable expectation that the United States Application would be completed with time to spare. Indeed, but for the server shut down, both applications would have been presented to the Post Office employee well in advance of 11 P.M. As explained in Applicants June 28, 2004 petition, the server shut down occurred in the middle of making final typographical corrections and printing the U.S. application ultimately assigned Serial No. 10/627,556, which delayed the completion and printing of the application (Collett Decl. ¶ 8; Kielt Decl. ¶ 8). It was unforeseeable to the personnel in the San Diego office of Buchanan Ingersoll that the computer server would shut down while completing and printing the subject U.S. application. No notification was received until a few minutes before the server shut down, and the computers and printers simply stopped working without advance warning (Hon Decl. ¶ 5; Collett Decl. ¶ 10). After shutting down, they were unavailable for the period of time that slowed delivery to the Post Office (Collett Decl. ¶ 8; Hon Decl. ¶ 3; Kielt Decl. ¶ 8).

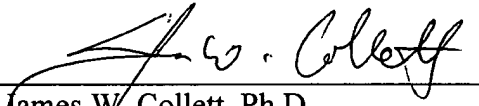
Applicants request reconsideration and relief from the unexpected convergence of extraordinary and unforeseeable events noted above, which were not due to simple inadvertence. The fact that the server shut down in the middle of printing the U.S. application, the change in hours at the Midway Post Office, pursuant to which live personnel refused to accept Express Mail packages, all combined to prevent Ms. Kielt from obtaining a date-in stamp of July 25, 2003, even though the patent applications were presented to the U.S. Post Office on that day for filing pursuant to PTO rules. The Post Office could have accepted the applications, but would not. As the designated agent for the Patent and Trademark Office, Applicants cannot be prejudiced by the unwarranted actions of the Post Office, by the inconsistencies of hours of operation for Express Mail at different Post Office locations, and by changes in those hours of operation after longstanding reliance had been established.

Conclusion

Based upon the foregoing information and Declarations, Applicants submit that the failure to obtain a July 25, 2003 filing date for the above-referenced patent application was an extraordinary situation that requires the suspension of rule 37 C.F.R. § 1.10 by the Commissioner in the interest of justice. Applicants respectfully request reconsideration and a decision that the filing date of the above-identified application be corrected to July 25, 2003. Please debit our Deposit Account No. 02-4553, as required under 37 C.F.R. §1.17(a) for payment of extension fees for this submission.

Respectfully submitted,

BUCHANAN INGERSOLL P.C.

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